

REMARKS

Upon entry of the instant Amendment, claims 1-30 will be pending in the application. By this amendment, claims 5, 21 and 23-26 are amended. Reconsideration of the rejected claims in view of the above amendments and the following remarks is respectfully requested.

Summary of the Official Action

In the Office action, the Examiner objected to certain claims as containing informalities. Additionally, claims 5-30 were rejected as being indefinite for allegedly omitting essential elements. The Examiner also rejected claims 5-11 and 25 over the applied art of record. Finally, claims 12-24 and 26-30 were indicated to contain allowable subject matter and would be allowed if amended to overcome the Section 112, 2nd paragraph, rejection. By the present amendment and remarks, Applicant submits that the objections and rejections have been overcome, and respectfully requests reconsideration of the outstanding Office Action and allowance of the present application.

Interview of September 9, 2009

Applicant thanks Examiners Merlino and Lugo for the personal Interview of September 9, 2009. In the interview, Applicant's representative discussed each of the objections and rejections noted in the Office Action of June 10, 2009.

It was agreed that the objection of claims 13, 18 and 22 would be withdrawn because these claims recite the term "only" and are therefore further limiting.

It was agreed that the objection of claims 23 and 24 would be overcome by Applicant amending the claims to address the noted deficiencies.

No agreement was reached regarding the Section 112, 2nd paragraph, rejection. Applicant's representative pointed out that MPEP 2172.01 is applicable to claim features which are specifically described in Applicant's specification as being essential and that only such specifically identified features are required to be recited in the claims consistent with MPEP 2172.01. None of the features identified by the Examiner have been specifically described in Applicant's specification as being essential. In response, the Examiner expressed disagreement and indicated that the 112, 2nd paragraph, rejection would likely be maintained. The Examiner did, however, agree to review Applicant's arguments after Applicant filed a response.

It was agreed that Applicant would amend the independent claim 5 to recite an electromagnet core arranged in the body and that the movable plate both contacts and supports the bolt in order to overcome the prior art rejections. It was agreed that the former feature was not taught in MANTHEY because the electromagnet core 6/7 is not in the body 4.2 (see Fig. 2). It was also agreed that the latter feature was not taught in CROCKETT because the plate f does not contact the bolts b' and h (see Fig. 1).

Finally, the Examiner suggested that Applicant amend each of the independent claims to recite essentially all of the features shown in Fig. 1 as well as the functional features recited in the method claims in order to overcome the Section 112, 2nd paragraph, rejection.

Objection to the Claims is Moot and/or Traversed

Claims 13, 18 and 22 were objected to allegedly because they do not further limit the claims from they depend. Claims 23 and 24 were objected to allegedly because they contain informalities.

As noted in the Interview, claims 13, 18 and 22 recite the term “only” and therefore further limit the claims from which they depend. The Examiner agreed to the same in the Interview.

With regard to claims 23 and 24, Applicant submits that the amendments presented herein correct the noted minor informalities.

Accordingly, Applicant respectfully requests that the above-noted objections be withdrawn.

The Section 112, 2nd paragraph, Rejection, is Improper

Claim 5-30 were rejected as allegedly being indefinite as being incomplete for omitting essential elements pursuant to MPEP 2172.01.

Applicant submits that they are not required under section 112, second paragraph, to limit the invention to any particular cooperative relationship between the recited structural features. Applicant respectfully submits the Examiner has misunderstood MPEP 2172.01, which indicates that when it is indicated “by applicant” in the specification that certain features are essential to the invention, such features must be recited in the claims. The Examiner has identified no features which were indicated “by Applicant” to be essential to the invention in the specification and which are not recited in the claims. In fact, Applicant has not asserted in the specification that certain devices are critical or essential to the invention. Certainly, none of the elements noted by the Examiner have been so described, and the Examiner has respectfully failed to point to any portion of the specification which supports the Examiner’s position that such devices are asserted to be critical. Accordingly, the Examiner’s reliance on MPEP 2172.01 is respectfully misplaced and this rejection is believed to be improper and should be withdrawn.

Moreover, Applicant is unaware of any requirement, under either the patent statutes or rules, requiring Applicant to limit the invention to any particular or preferred disclosed embodiment. Applicant submits that if the claim limitations are clear and have support in the specification, they cannot be properly rejected as indefinite merely because the Examiner would prefer that the claims recite more detailed limitations.

Furthermore, the Examiner has set forth no legal basis for requiring Applicant to limit the invention in the suggested manner. Section 112, 2nd paragraph, does not require Applicant to specify the relationship between all of the parts of the lock shown in Fig. 1. Applicant submits that the requirement that the claims be interpreted in light of the specification provides sufficient basis for the claims being definite. The Examiner is reminded that Applicant is entitled to the broadest reasonable interpretation permitted by the prior art, and that one of ordinary skill in the art, having read the specification, would understand that which is claimed.

Applicant also submits herein for the Examiner's consideration a copy of the non-precedential decision *Ex parte COULAS Sr.* which addressed a similar rejection and noted that if the scope of the invention can be determined from the claim language with a reasonable degree of certainty, a rejection under Section 112, 2nd paragraph, is inappropriate (see pages 3-6).

Accordingly, Applicant requests that the Examiner reconsider and withdraw the rejection of these claims.

Rejection Under 35 U.S.C. §102 Rejections

Over Manthey

Claims 5-8 and 11 were rejected under 35 U.S.C. §102(b) for being anticipated by U.S. Patent No. 6,630,877 to MANTHEY. This rejection is respectfully traversed.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See MPEP §2131. Applicant submits that the applied art does not show each and every feature of the claimed invention.

The present invention relates to an electromagnetic lock which utilizes a linearly movable bolt member which can move from the position shown in Figs. 1 and 2 (the protruding position) to the position shown in Fig. 3 (a retracted position) and vice versa.

More specifically, claim 5 recites:

5. An electromagnetic lock comprising:
 a body;
 a linearly movable retractable sliding bolt; and
 an electromagnet core arranged in the body; and
 a movable plate arranged in the body and being structured and arranged to contact and support the retractable sliding bolt and to function as an armature of an electromagnet,
 wherein the movable plate is movable via two forces acting in the same direction and is structured and arranged to move the retractable sliding bolt linearly to a protruding position.

As asserted in the Interview and agreed to by the Examiner, MANTHEY teaches an electromagnet core 6/7 that is arranged outside the body 4.2. As such, MANTHEY does not teach an electromagnet core arranged in the body 4.2. Nor would it be obvious to modify MANTHEY. MANTHEY specifically places the core 6/6 in the door frame 1 and not in the door 8. On the other hand, the body 4.2 is arranged in the door 8. Thus, there is no basis for moving the core 6/7 into the body 4.2 as it would have to also be moved from the door casing to the door. Finally, such a modification, even if proper (which Applicant would dispute), would appear to destroy the functioning of the lock shown in Fig. 2 of MANTHEY.

Thus, Applicant submits that MANTHEY does not disclose all of the features of at least claim 5 and does not anticipate the claimed invention.

Regarding claims 6-8 and 11, Applicant respectfully submits that these claims depend from allowable claim 5, and are distinguishable from MANTHEY at least for the reasons described above with respect to claim 5. Moreover, these claims recite additional features that are not disclosed or suggested by MANTHEY.

Accordingly, Applicant respectfully requests that the rejection over the above-noted claims be withdrawn.

Over Crockett

Claims 5-10 and 25 (claims 10 and 25 were mentioned in the body of the rejection) were rejected under 35 U.S.C. §102(b) for being anticipated by U.S. Patent No. 473,061 to CROCKETT. This rejection is respectfully traversed.

Again, the present invention relates to an electromagnetic lock which utilizes a linearly movable bolt member which can move from the position shown in Figs. 1 and 2 (the protruding position) to the position shown in Fig. 3 (a retracted position) and vice versa.

More specifically, claim 5 recites:

- 5. An electromagnetic lock comprising:
 - a body;
 - a linearly movable retractable sliding bolt; and
 - an electromagnet core arranged in the body; and
 - a movable plate arranged in the body and being structured and arranged to contact and support the retractable sliding bolt and to function as an armature of an electromagnet,
- wherein the movable plate is movable via two forces acting in the same direction and is structured and arranged to move the retractable sliding bolt linearly to a protruding position.

As asserted in the Interview and agreed to by the Examiner, CROCKETT teaches a movable plate f' contacts member d^2 and not the bolts b' and h (see Fig. 1). As such, CROCKETT does not teach a movable plate arranged in the body and being structured and arranged to contact and support the retractable sliding bolt and to function as an armature of an electromagnet. Nor would it have been obvious to modify CROCKETT in any manner that would render the pending claims unpatentable. CROCKETT specifically mounts the plate f' in a pivoting manner so as to cause pivoting movement of the member d^2 . The pivoting movement of member d^2 in turn causes linear movement of the bolts b' and h . There is no basis for modifying the plate f' so as to contact the bolts b' and h as it would likely require elimination of member d^2 . Finally, such a modification, even if proper (which Applicant would dispute), would appear to destroy the functioning of the lock shown in Fig. 1 of CROCKETT.

Thus, Applicant submits that CROCKETT does not disclose all of the features of at least claim 5 and does not anticipate the claimed invention.

Regarding claims 6-10 and 25, Applicant respectfully submits that these claims depend from allowable claim 5, and are distinguishable from CROCKETT at least for the reasons described above with respect to claim 5. Moreover, these claims recite additional features that are not disclosed or suggested by CROCKETT.

Accordingly, Applicant respectfully requests that the rejection over the above-noted claims be withdrawn.

Allowable Subject Matter

Applicant acknowledges that claims 12-24 and 26-30 have been indicated to contain allowable subject matter and would be allowed or allowable if amended to overcome the Section

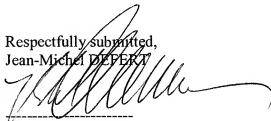
112, 2nd paragraph, rejection. As Applicant has demonstrated that the Section 112, 2nd paragraph, is improper, Applicant submits that these claims should be indicated to be allowed and/or allowable. Furthermore, as Applicant has addressed the claim objections and the prior art rejections, it is submitted that all of the claims are in condition for allowance and should be indicated as allowed.

CONCLUSION

In view of the foregoing amendments and remarks, Applicant submits that all of the claims are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed. Applicant hereby makes a written conditional petition for extension of time, if required.

Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 19-0089.

Respectfully submitted,
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The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 32

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte JAMES J. COULAS SR.

Appeal No. 2002-1677
Application No. 08/944,817

ON BRIEF

Before COHEN, STAAB, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 11 and 14 to 16. Claim 17 has been withdrawn from consideration. Claims 12 and 13 have been canceled.

We REVERSE and REMAND.

BACKGROUND

The appellant's invention relates to flanges for connecting piping to various components such as pumps, valves, tanks, heat exchangers and so forth (specification, p. 2). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Calvin

5,188,396

Feb. 23, 1993

Claims 1 to 11 stand rejected under 35 U.S.C. § 112, second paragraph, as being incomplete.

Claims 1 to 3, 6 to 9 and 14 to 16 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Calvin.

Claims 4, 5, 10 and 11 stand rejected under 35 U.S.C. § 103 as being unpatentable over Calvin.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the final rejection (Paper No. 19, mailed February 26, 2001) and the answer (Paper No. 25, mailed December 12, 2001) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 24, filed November 20, 2001) and reply brief (Paper No. 28, filed February 12, 2002) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art reference, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The indefiniteness rejection

We will not sustain the rejection of claims 1 to 11 under 35 U.S.C. § 112, second paragraph.

In the rejection of claims 1 to 11 under the second paragraph of 35 U.S.C. § 112, the examiner (final rejection, pp. 3-4) concluded that these claims were incomplete for omitting essential elements, such omission amounting to a gap between the elements.

The examiner identified the omitted element as a clamp which, at a minimum, appears to be necessary to assemble the claimed elements into a single system.

The appellant argues (brief, p. 7; reply brief, p. 3) that claims 1 to 11 provide a reasonable degree of precision and particularity in reciting the claimed subject matter and thus comply with the requirements of the second paragraph of 35 U.S.C.

§ 112.

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In making this determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id.

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. § 112, second paragraph, is whether the claims meet the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. Some latitude in the manner

of expression and the aptness of terms is permitted even though the claim language is not as precise as the examiner might desire. If the scope of the invention sought to be patented can be determined from the language of the claims with a reasonable degree of certainty, a rejection of the claims under 35 U.S.C. § 112, second paragraph, is inappropriate.

With this as background, it is our opinion that claims 1 to 11 comply with the requirements of the second paragraph of 35 U.S.C. § 112. In that regard, while the claims do not positively recite a clamp (as in claims 13 to 16), we do not see that such is dictated by the language of 35 U.S.C. § 112, second paragraph.

Claim 1, for example, is drawn to a pipe-to-component connector system, comprising, inter alia, a forged flange and a metallic piping segment. We see no requirement in the language of the second paragraph of 35 U.S.C. § 112 for claim 1 to further recite a clamp to connect and the forged flange and the metallic piping segment together. Claim 1 is clearly drawn to a pipe-to-component connector system having a forged flange and a metallic piping segment and as such define the metes and bounds thereof with a reasonable degree of precision and particularity.

For the reasons set forth above, the decision of the examiner to reject claims 1 to 11 under 35 U.S.C. § 112, second paragraph, is reversed.

The anticipation rejection

We will not sustain the rejection of claims 1 to 3, 6 to 9 and 14 to 16 under 35 U.S.C. § 102(b).

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). In other words, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). When the claimed invention is not identically disclosed in a reference, and instead requires picking and choosing among a number of different options disclosed by the reference, then the reference does not anticipate. Thus, the invention must have been known to the art in the detail of the claim; that is, all of the elements and limitations of the claim must be shown in a single prior reference, arranged as in the claim. See Karsten Mfg. Corp. v. Cleveland Gulf Co., 242 F.3d 1376, 1383, 58 USPQ2d 1286, 1291 (Fed. Cir. 2001);

Akzo N.V. v. International Trade Commission, 808 F.2d 1471, 1480, 1 USPQ2d 1241, 1245-46 (Fed. Cir. 1986), cert. denied, 107 S.Ct. 2490 (1987); In re Arkley, 455 F.2d 586, 587-88, 172 USPQ 524, 526 (CCPA 1972).

In the anticipation rejection before us in this appeal, the examiner (final rejection, p. 2) ascertained that Figure 2 of Calvin

shows a pipe-to-component connector system comprising: a forged (see "wrought" in col. 1, line 30) steel (which is a material in accordance with ASTM Std A105, see p.22 item 4.1 of the standard.) flange 26 with an extended neck 14 with a circumferential groove and a raised portion; and a metallic piping segment "P" with a circumferential groove. The grooves are shown as cooperating in order to receive a clamp 24. In col. 6, Calvin discloses that flange 26 is made according to U.S. standards.

The appellant argues (brief, pp. 4-5; reply brief, p. 2) that the claimed "forged flange" limitation present in each of claims 1 to 3, 6 to 9 and 14 to 16 is not met by Calvin's section 14 having a flange 26. We agree. While Calvin teaches (column 1, lines 24-29) that "[i]t is well know that hardened metal has superior abrasion resistance, and that a wrought metal housing has desirable strength properties. U.S. Pat. No. 5,044,670, issued to Alexander Esser on Sep. 3, 1991, exemplifies the use of hardened metal wear surfaces and a wrought steel outer member," Calvin does not teach that sections 14 with flanges 26 are made from a hardened/wrought/forged metal. Accordingly, we can not support the examiner's rationale for the rejection of claims 1 to

3, 6 to 9 and 14 to 16 under 35 U.S.C. § 102(b). For this rationale to have been proper, Calvin must clearly and unequivocally disclose the claimed subject matter without any need for picking, choosing, and combining various disclosures not directly related to each other by the specific teachings of Calvin. Such picking and choosing **may** be proper in the making of a 35 U.S.C. § 103, obviousness rejection, where the appellant will be afforded an opportunity to rebut with objective evidence any rejection under 35 U.S.C. § 103, but it has no place in the making of a 35 U.S.C. § 102 anticipation rejection. See *In re Arkley*, 455 F.2d at 587, 172 USPQ at 526.

For the reasons set forth above, the decision of the examiner to reject claims 1 to 3, 6 to 9 and 14 to 16 under 35 U.S.C. § 102(b) is reversed.

The obviousness rejection

We will not sustain the rejection of claims 4, 5, 10 and 11 under 35 U.S.C. § 103.

In the rejection of dependent claims 4, 5, 10 and 11 under 35 U.S.C. § 103, the examiner determined (final rejection, p. 4) that the claimed rectangular grooves would have been obvious at the time the invention was made to a person of ordinary skill in the art.

The appellant argues (brief, p. 6) that the claimed "forged flange" limitation present in each of claims 4, 5, 10 and 11 is not met by Calvin. We agree for the reasons set forth above. Moreover, in the rejection under 35 U.S.C. § 103 before us in the appeal, the examiner has not determined that it would have been obvious at the time the invention was made to a person of ordinary skill in the art to have made Calvin's sections 14 from a forged material. Thus, the examiner has not established a basis for concluding that the claimed subject matter is unpatentable under 35 U.S.C. § 103.

For the reasons set forth above, the decision of the examiner to reject claims 4, 5, 10 and 11 under 35 U.S.C. § 103 is reversed.

REMAND

We remand this application to the examiner to consider whether or not the claims pending in this application are patentable under 35 U.S.C. § 103 over the appellant's admission of prior art (specification, pages 2-3)¹ in view of the prior art teaching of the use of a clamp to connect piping to a component/flange (e.g., Calvin).

¹ The admission relates to a forged flange for connecting piping to various components such as pumps, valves, tanks, heat exchangers, etc. wherein the piping is connected to the forged flange by welding and the forged flange is connected to the component by bolts.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 11 under 35 U.S.C. § 112, second paragraph, is reversed; the decision of the examiner to reject claims 1 to 3, 6 to 9 and 14 to 16 under 35 U.S.C. § 102(b) is reversed; and the decision of the examiner to reject claims 4, 5, 10 and 11 under 35 U.S.C. § 103 is reversed. In addition, the application has been remanded to the examiner for further consideration.

REVERSED; REMANDED

IRWIN CHARLES COHEN
Administrative Patent Judge

LAWRENCE J. STAAB
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

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